

REMARKS

Claims 1-29 were previously pending and claims 30 and 31 have been added. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejection of the Independent Claims

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Referring to independent claims 1 and 12, contrary to the examiner's position that all elements are disclosed in the Joo patent, the latter reference does not disclose "depositing a blanket third metal layer on said substrate and over said portions, and etching back to form sidewall spacers on said portions to provide lower electrodes for said capacitors." In contrast, the Joo patent teaches "sidewall spacers 8 are formed on both sides of the lower electrode 7 and the TiW layer by using an *oxide*." (col. 2, lines 30-32, emphasis added).

Therefore, the rejection of the independent claims is not supported by the Joo patent and should be withdrawn.

Rejection of the Dependent Claims

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for the following, mutually exclusive, reasons.

The cited patents cannot be applied to reject claim the dependent claims under 35 U.S.C. § 103 because the references are not properly combinable if their intended function is destroyed. Thus, since the combination of references cited by the examiner clearly destroys the purpose or function of the invention disclosed in the present application, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Furthermore, the cited references neither teach nor suggest the desirability of the combination since neither teaches the specific arrangement described in the claims. Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination.

Conclusion

An early formal notice of allowance of claims 1-29 is respectfully requested.

Respectfully submitted,



David M. O'Dell
Registration No. 42,044

Dated: 8-17-04

HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972-739-8635
Facsimile: 214-200-0853
Client Matter No.: 24061.443
R-82133_1.DOC

<p>I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450</p> <p>on: <u>8-18-04</u></p> <p><u>Bonnie Boyle</u> Signature of person mailing paper and fee</p>
--